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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/923,932	08/07/2001	Richard Emil Kajander	7144	3935

7590 06/18/2003

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EXAMINER	
VO, HAI	

ART UNIT	PAPER NUMBER
1771	

DATE MAILED: 06/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Application No.	Applicant(s)
09/923,932	KAJANDER ET AL.
Examiner	**Art Unit**
Hai Vo	1771

Office Action Summary

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 March 2003*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *16-26 and 41-51* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *16-26 and 41-51* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a)☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *4*.
4)☐ Interview Summary (PTO-413) Paper No(s). _____.
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other: .

1. Claims 1-15, 27-40 and 52-56 have been cancelled in the amendment received on 04/08/2003.

Claim Objections

2. Claim 25 is objected to because of the following informalities: the term "a" needs to be added before the phrase --gypsum board--. Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 16-24, 26, 41-49, and 51 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Horner, Jr. et al. (US 6,365,533). Horner, Jr. teaches a foam coated mat comprising a fibrous non-woven mat and a thin foam coating applied onto the top surface of the mat (abstract). Horner, Jr. teaches the foam coated mat being applied to a foamed polyurethane core (example 2). Horner, Jr. teaches the foam having a viscosity of 1500 cps (column 7, line 27), meeting the specific range required by the claims. The foam has a density of 0.23 g/cc (example 3). Horner, Jr. teaches the preformed glass fiber mat comprising 27.5 wt % binder, 72.5 wt % fiber within the range disclosed in Applicants' specification (10-30 wt% binder, 40-80 wt% fiber, see page 9, lines 31-35). Horner, Jr. teaches the coated foam mat having a basis weight of 13.1 lbs per 480 sq. feet closed to a value disclosed in Applicants' specification (2.7 lbs per 100 sq. feet, see page 16, line 24). Horner, Jr. is silent as to a blow ratio. However, Horner, Jr. is using the foam that has a very low density and viscosity within the claimed range. Since density and viscosity together dictate the blow ratio, it is the examiner's position that a blow ratio would be inherently present. Horner, Jr. does not specifically disclose an air permeability of the foam coated mat. However, Horner, Jr. is using the same composition of fiber and binder to form a foam coated mat as Applicant. Since the air permeability of the mat is determined by the concentration of the binder

and the fiber in the composition, it is the examiner's position that the air permeability would be inherently present. Products of identical chemical composition can not have mutually exclusive properties. In re Spada, 15 USPQ 2d 1655 (1990). Note In re Best 195 USPQ at 433, footnote 4 (CCPA 1977) as to the providing of this rejection under 35 USC 103 in addition to the rejection made under 35 USC 102.

Although Horner, Jr. does not disclose the foam coated mat made of a process set out in the claims, it is the examiner's position that the article of Horner, Jr. is identical to or only slightly different than the claimed article prepared by the method of the claim, because both articles are formed from the same materials, having structural similarity (foam coating/non-woven fibrous layer). Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or an obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. ***In re Thorpe***, 227 USPQ 964, 966 (Fed. Cir. 1985). The burden has been shifted to the applicant to show unobvious differences between the claimed product and the prior art product. ***In re Marosi***, 218 USPQ 289,291 (Fed. Cir. 1983). The Horner reference either anticipates or strongly suggests the claimed subject matter. It is noted that if the applicant intends to rely on Examples in the specification or in a submitted Declaration to

show non-obviousness, the applicant should clearly state how the Examples of the present invention are commensurate in scope with the claims and how the Comparative Examples are commensurate in scope with Horner.

6. Claims 25 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horner, Jr. et al. (US 6,365,533) as applied to claim 24 above, and further in view of WO 00/76932. Horner is silent as to the first layer is a gypsum board. WO'932 teaches a process for applying a foam coating to a fiber glass mat to prevent glass fibers from becoming entangled in other products (abstract, page 2, lines 22-24). WO'932 teaches the foam coated mat being applied to a substrate such as gypsum board to provide the gypsum board with increased strength (page 1, lines 5- 10). It would have been obvious to one having ordinary skill in the art at the time the invention was made to apply the foam coated mat onto a gypsum board motivated to provide the gypsum board with increased strength.

Response to Arguments

7. The art rejections in Paper no. 3 have been overcome by the present amendment, Applicants' arguments and declaration.
8. Applicant's arguments with respect to claims 16-26, 41-49 have been considered but are moot in view of the new ground(s) of rejection.
9. Arguments that the foam taught in Horner reference has a much lower air content and a much higher density than the foam used to make the mat of the present invention are not found persuasive. Horner, Jr. does not disclose the coated

foam mat having a low air permeability but rather a low liquid permeability (column 4, lines 16-20). Further, the arguments are not commensurate in scope with the claims. Nothing specific about the foam density has been included in the claims. In addition, Applicants argue that the highest blow ratio taught by Horner is about 5. Applicants need to show where it is found in the Horner reference.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (703) 605-

4426. The examiner can normally be reached on Tue-Fri, 8:30-6:00 and on alternating Mondays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (703) 308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

HV
June 14, 2003

ELIZABETH M. COLE
PRIMARY EXAMINER